

No claims are added, cancelled, or amended. Hence, Claims 1-26 are pending in the application.

I. SUMMARY OF THE REJECTIONS

Claims 1-9, 11-22, and 24-26 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,738,770 issued to Gorman ("*Gorman*"). This rejection is respectfully traversed.

Claims 10 and 23 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Gorman* in view of U.S. Patent Publication No. 2003/0110227 to O'Hagan ("*O'Hagan*"). This rejection is respectfully traversed.

II. DECLARATION UNDER 37 CFR § 1.131

The attached declaration proves that an implementation of Claims 1 – 26 was developed and successfully tested before the provisional filing date of *Gorman*, which is November 4, 2000. Therefore, Claims 1 – 26 were reduced to practice by the inventor before the provisional filing date of *Gorman*. *Gorman* cannot be used as a valid basis for rejecting Claims 1 – 26 under 102(e) or 103(a). Reconsideration and allowance of Claims 1 – 26 is respectfully requested.

A. Applicant Not Required to Show Diligence

In the “Response to Arguments” section (page 9), the Final Office Action alleges that the previous declaration is ineffective to overcome *Gorman*. Specifically, the Final Office Action stated that the “evidence submitted is insufficient to establish **diligence** from a date prior to the date of reduction to practice of the [*Gorman*] reference to either a constructive reduction to practice or an actual reduction to practice” (emphasis added). However, Applicant is not attempting to prove diligence.

37 C.F.R. § 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter, one of which is an actual reduction to practice of the invention prior to the effective date of the reference (see also MPEP § 715.07(III)). No diligence is required in that case.

B. Evidence is Sufficient to Establish a Reduction to Practice

The Final Office Action also asserts that the evidence submitted is insufficient to establish a reduction to practice of the invention (page 9). Specifically, the Final Office Action alleges that “there are no factual assertions sufficient to show the claimed subject matter. Applicant’s lack any exhibits, which state any of the claim limitations.” It is respectfully submitted that this is incorrect.

1. Exhibits are not required by the C.F.R. or the MPEP

37 C.F.R. § 1.131(b) does not require evidence to be submitted in the form of exhibits.

Rather, that section states:

The showing of facts shall be such, **in character and weight, as to establish reduction to practice prior to the effective date of the reference**, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration **or their absence must be satisfactorily explained**. (emphasis added)

Thus, exhibits are not required. Instead, what is required is a showing of facts that, in character and weight, establishes reduction to practice prior to the effective date of the reference. MPEP § 715.07(I) is consistent with 37 C.F.R. § 1.131(b) when MPEP § 715.07(I) states: “Evidence in the form of exhibits **may** accompany the affidavit or declaration” (emphasis added).

Additionally, MPEP § 715.07(I) further states that claimed limitations may be supported by the

declaration itself rather than by an exhibit (see also *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989)).

The MPEP has warned against providing general allegations in declarations. However, the attached declaration (as well as the previous declaration) is very specific. The inventor composed software that, when executed, implemented Claims 1-26 before November 4, 2000 (Declaration ¶ 3). Successful tests were run, before November 4, 2000 and in this country, to show that the software worked according to Claims 1-26 (Declaration ¶ 4). The software, when executed by a computer, causes the computer to perform the specific steps of Claim 1 and Claim 11 and each of the remaining dependent method claims (Declaration ¶ 5-7). The declaration itself is direct evidence of a reduction to practice of the claimed invention.

Furthermore, the courts have stated that “the PTO is required to accept Rule 131 Affidavits at **face value**, and **without investigation**” (see, e.g., *Herman v. Williams Brooks Shoe Co.*, 39 USPQ2d 1773, 1777 (S.D. N.Y. 1996); see also Chisum on Patents § 3.08[1][a] (2005); emphasis added). Based on the specific evidence provided in the declaration, the Applicant has satisfied his burden to prove that a working implementation of the invention according to Claims 1-26 existed prior to November 4, 2000.

2. *Absence of exhibits are satisfactorily explained*

If exhibits do not accompany a declaration, then 37 C.F.R. § 1.131(b) requires a satisfactory explanation of their absence. There are valid and common sense reasons why exhibits do not accompany and form part of the subject declaration. Such reasons are stated in paragraph 9 of the attached declaration.

First, the files that comprise the subject software were not part of a database code tree (maintained by the Applicant’s employer) at a time prior to November 4, 2000 and, therefore, there are no log files showing that those files were part of that database code tree.

Second, although software developers may communicate with their superiors via email regarding the progress of a software project, typical company email is subject to storage quotas. In this case, where the date in question is November 4, 2000, it is not surprising that the inventor's email messages before that date (over six years ago) was subject to such a storage quota. Therefore, there is no email trail of the invention.

Third, the life cycle of typical software development comprises (1) designing software, (2) composing the software, (3) running tests against the software, (4) debugging the software, (5) repeating steps (3) and (4) until the tests are successful, and, if the software is still deemed worthy to use, (6) incorporating the software into a useable product either for internal or external use. It is not uncommon for software developers to not retain a permanent record of any work performed at any of these stages. Here, the inventor followed convention and did not retain a permanent record of his work during any of these stages.

Based on the foregoing, it is respectfully submitted that the declaration is sufficient to establish a reduction to practice of the inventions according to Claims 1-26. The specific declarations must be accepted at face value and the absence of exhibits is satisfactorily explained.

III. CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

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